

REMARKS

Claims 1-53 are now pending in this application. The non-final Office Action mailed March 30, 2004 rejected claims 1-53 and objected to claim 53. Applicants have amended claims 1, 3, 5, 13, 33, 37, 48, 50-51, and 53. Claims 4 and 39 are canceled. No new matter has been added. For the reasons discussed in detail below, Applicants submit that the pending claims are patentable over the art of record and respectfully request that the Examiner pass this application to issue.

Telephonic Interview

On June 29, 2004, a telephonic interview was conducted with the Examiner with respect to the pending claims. The Applicants wish to thank the Examiner for taking the time to discuss the claimed invention.

During the interview, the Applicants discussed the differences between the use of an internal program pointer employed in a cited prior art and the present invention's use of a cursor that may be viewable or displayable, such as in a screen display, and may be movable directly by a user. Although no conclusive agreement was reached, there was general agreement that there is a difference between a cursor as known in the industry and an internal program pointer. In addition to this discussion, the Examiner suggested moving dependent claim 4 into independent claim 1. The Applicants also agreed to amend the claims to employ the term cursor, where appropriate.

Rejection of Claims 1-53:

The Office Action rejected claims 1-53 under 35 U.S.C. §112 as failing to comply with the written description requirement. Claims 1, 5, 48, 50, and 51 have been amended to employ the phrase "nearest word to a cursor." This phrase is supported in the specification at page 9, lines 1-3. Therefore, Applicants respectfully submit that this rejection is now moot and should be withdrawn.

Claim Objections:

The Office Action objected to Claim 53 because step (f) is incomplete. Applicants wish to thank the Examiner for catching this typographical error. Applicants have amended Claim 53 only to add back the text from the original Claim that was inadvertently dropped.

Rejection of Claims under 35 U.S.C. §103(a)

The Office Action has rejected Claims 1-3, 5-16, 19-30, 37, 39, 48, and 50 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,021,412 to Ho et al. (hereinafter "Ho") in view of U.S. Patent No. 6,108,674 to Murakami et al. (hereinafter "Murakami"). Applicants respectfully traverse these rejections.

The Applicants respectfully submit that the prior art reference does not teach or suggest all of the claimed limitations. For example, amended Claim 1 recites a method for searching a database to obtain an object that is related to an indicated object in a document, comprising, inter alia, automatically creating a query directly from the indicated object, the query having a data structure that is recognizable by a search engine for the database, wherein the query is created by selecting a nearest word to a cursor without having a user make a selection for the query in a separate document. See Specification, Page 9, lines 1-3.

Ho describes a method and system for automatically adding graphics to a document to illustrate concepts referred therein. See Ho, Abstract, Col. 1, lines 38-40. Unlike the claimed invention, Ho's method identifies words in a document representing concepts to be illustrated. In one embodiment of Ho, a facility examines **all of the words occurring anywhere in the presentation document** that matches one of a concept matching word. In another embodiment of Ho, the facility examines the words occurring on a current slide of the document, and searches for words on the current slide that match one of the concept matching words and allows the user to add an instance of graphics to the document illustrating the concept referred to by each such word. In still another embodiment, Ho's facility examines each word in the document as it is inputted by the user. See, Ho, Col. 3, 40-65. Ho examines every word in the document or on a slide. This

distinction is important, because Ho does not select a nearest word to a cursor. Ho does not disclose or suggest selecting the nearest word to the cursor. Therefore, for at least this reason, Ho does not make obvious the claimed invention.

The Office Action attempts to argue that Ho's pointer is similar to the Applicant's cursor. However, as described by Ho at Col 7, lines 15-25, Ho's pointer is initialized to the beginning of the current slide and a facility (an automatic software facility) uses the pointer to keep track of the words on the current slide of the document that have already been searched for concept matching words. Thus, Ho's pointer appears to function as an internal program pointer. It is the facility, not the user, which may directly manipulate the pointer (other than by changing to another slide). Thus, Ho's pointer does not suggest nor describe a cursor, such as is known by one of ordinary skill in the art. Ho's pointer is not a cursor. Thus, for at least this reason, Ho does not render the claimed invention obvious.

Murakami discloses an image output device, wherein a keyboard is used to enter document data in addition to various commands, and a word retrieval unit sequentially compares respective character strings from the entered document data to image classification data to retrieve images. Murakami, Abstract, Col. 3, lines 42-45 and 47-50. Thus, Murakami also fails to disclose or suggest selecting the nearest word to a cursor as basis for a query. Therefore, Ho with Murakami does not make obvious the claimed invention.

Additionally, the law is clear that it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F2d 731, 743 (Fed. Cir. 1983); MPEP §2145. Murakami states that where a user selects a desired image from among many displayed image candidates, the display screen must be switched many times, so that much labor and time would be spent before a desired image which satisfies the user is located. See Murakami, Col. 1 lines 25-50. Thus, Murakami is arranged to extract one-image data from among various image data. See Murakami, Col. 2, lines 1-5. Thus, Murakami actually teaches away from the approach described in Ho. See Ho, Figures 10-11, and Col. 6, lines 19-34. Therefore, it is improper to

combine Murakami with Ho. Thus, for at least this reason, rejection of the claimed invention is improper and should be withdrawn.

Therefore, Applicants submit that at least because of the reasons presented above, the cited art does not make Claim 1 obvious. Additionally, because independent Claims 5, 48, 50, and 51 include a similar limitation as Claim 1, albeit different, they are also allowable for at least substantially the same reasons as independent Claim 1.

In regard to Claims 2-3, 6-38 and 40-47, 49, and 52-53 which are dependent on amended independent Claims 1, 5, 48, and 51, respectively, they are allowable for at least the same reasons discussed above for those independent claims.

The Office Action further rejected independent Claim 51 under 35 U.S.C. §103(a) as being unpatentable over Ho and Murakami, and further in view of U.S. Patent No. 5,493,677 to Balogh et al. (hereinafter "Balogh"). The Applicants further traverse this rejection.

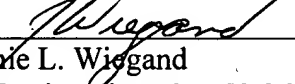
Balogh describes enabling the user to purchase rights to, and obtain delivery of, selected images through a purchase/delivery service. See Balogh, Col. 17, Lines 39-44. However, Balogh does not describe nor suggest "when the related image is purchased, inserting the related image into the document," as is claimed in Claim 51. Instead, Balogh allows the user to receive the image file electronically using a conventional bulletin board service. The image is placed onto the bulletin board for retrieval by the user. See Balogh, Col 18, Lines 1-15. Thus, Balogh does not teach or suggest inserting the related image into the document. Therefore, for at least this additional reason Claim 51 is not made obvious by Ho, Murakami, and Balogh. As Claim 1 includes a similar limitation as Claim 51, albeit different, it is further allowable for at least substantially the same reason. Thus, Applicants respectfully request the rejection for Claims 1 and 51 be withdrawn.

CONCLUSION

By the foregoing explanations, Applicant believes that this response has responded fully to all of the concerns expressed in the Office Action, and believes that it has placed each of the pending claims in condition for immediate allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. Should any further aspects of the application remain unresolved, the Examiner is invited to telephone applicant's attorney at the number listed below.

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Respectfully submitted,

By 
Jamie L. Wiegand
Registration No.: 52,361
DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257
(202) 262-8900
(212) 753-6237 (Fax)
Attorneys/Agents For Applicant

Customer No.: 39179